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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,802	08/17/2001	Jon Hall	IN-5521	5868
26922	7590	09/27/2005	EXAMINER	
			JACKSON, MONIQUE R	
		ART UNIT		PAPER NUMBER
				1773

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/932,802	HALL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Monique R. Jackson	1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 July 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,6-14,16-41 and 43-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,6-14,16-41 and 43-70 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. The amendment filed 7/19/05 has been entered. Claims 1-4, 6-14, 16-41 and 43-70 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Rejections - 35 USC § 102*

3. Claims 38-39, 41, 43-44, 52, 57-59, 62 and 64-66 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11048399A (JP'399.) JP'399 teaches a metallic body comprising a colored resin coat and an at least somewhat transparent fluorescent topcoat comprising 5-200 wt parts of phosphorescent pigment blended with 100 wt parts of a silicone clear coating and colored similar to the color of the resin coat layer such that the color pigment intercept light other than sufficient to excite the fluorescent substance extending the endurance of the phosphorescent properties (Abstract; 0006, 0009, 0010.) JP'399 further teach that the resin coat is a powder coating formed from a curable resin and the topcoat is formed from a curable organic silicone or siloxane system, wherein the pigments may be inorganic or organic pigments of various colors (0014, 0017, 0020.) In terms of the fluorescent substance, JP'399 teach that the fluorescent substance desirably has a particle size of less than 30 micrometers and is generally rare earth oxides, such as heavy metal and europium, etc. to metallic oxides such as aluminum, calcium, barium, magnesium, zinc, cadmium, and strontium, as an activator may be utilized wherein the quality, configuration and excitation wavelength may be determined based on the desired end use of the product, and specifically teaches examples utilizing 0.8BaO:1.0MgO:8.0Al<sub>2</sub>O<sub>3</sub>:0.1EuO:0.5MnO (0018.) With respect to the product-by-process

limitations regarding wet-on-wet application, simultaneous curing, application by spraying, etc., the Examiner takes the position that these limitations are process limitations that do not materially affect the final cured product instantly claimed wherein the final product of JP'399 appears to be the same as the final product of the instant claims.

***Claim Rejections - 35 USC § 103***

4. Claims 1-4, 6-14, 16-35, 38-40, 45-51, 53-56, 60-61, 63, and 67-69 rejected under 35 U.S.C. 103(a) as being unpatentable over JP'399. The teachings of JP'399 are discussed above and though JP'399 teaches that the pigmented resin coat is applied as a powder coating versus a liquid coating in order to obtain a thicker, pinhole-free layer by a one paint process, wet-on-wet application of a pigmented base coat followed by a clear topcoat with simultaneous curing would have been obvious to one having ordinary skill in the art at the time of the invention considering a wet-on-wet process is a functionally equivalent method to the method taught by JP'399. Further, though JP'399 teach that the pigmented resin coat may include inorganic and/or organic pigments of various colors, JP'399 does not specifically teach the amount of pigmented added to the coating however considering the amount is a result-effective variable affecting the final color of the resin layer, one having ordinary skill in the art at the time of the invention would have been motivated to determine the optimum amount and type of pigment to provide the desired aesthetic properties for a particular end use. With regards to the phosphorescent properties, JP'399 teach the general phosphorescent pigments as instantly claimed and further teach that the quality, configuration and excitation wavelength may be determined based on the desired end use of the product and hence it would have been obvious to one skilled in the art to determine the

optimum type, amount and size of the phosphorescent pigment to utilize to provide the desired phosphorescent properties for a particular end use.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-4, 6-14, 16-41 and 43-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-13, 19-22, 24-29 and 35 of U.S. Patent No. 6,789,905. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time of the invention to combine dependent claim limitations and to determine the optimum type, amount and size of the phosphorescent pigment to utilize to provide the desired phosphorescent properties for a particular end use. Further, though the instant invention includes method claims, it would have been obvious to one skilled in the art to convert the product-by-process limitations of the patent to the instantly claimed method.

***Response to Arguments***

7. Applicant's arguments filed 7/19/05 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
Technology Center 1700  
September 21, 2005